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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

PHILIP R. THRIFT ET AL.

Serial No. 08/419,229 (TI-20205)

Filed April 10, 1995

For: VOICE ACTIVATED HYPERMEDIA SYSTEMS
USING GRAMMATICAL METADATA

Art Unit 2654

Examiner Richemond Dorvil

Customer No. 23494

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4-4-05

Jay M. Cantor, Reg. No. 19,906

REQUEST FOR RECONSIDERATION
OF DECISION ON PETITION BY COMMISSIONER

Sir:

Responsive to the decision on petition, which is stated to be a non-final agency action, reconsideration by the Commissioner is respectfully requested.

The facts are that all pending claims were finally rejected and appealed. The Board of Patent Appeals and Interferences affirmed the final rejection by the examiner. The Decision of the Board was appealed to the Court of Appeals for the Federal Circuit (CAFC). The CAFC affirmed the rejection of claims 1 to 10 and remanded as to claims 11 to 19 for further proceedings with respect to claims 11 to 19.

With respect to claim 11, the CAFC stated, commencing at the bottom of page 12 of the slip opinion that

“the examiner summarily rejected claim 11’s grammar-creation capability limitations, stating that ‘[t]he use of grammar is old and well known in the art of speech recognition as a means of optimization which is highly desirable.’ Aug. 7, 1996 Office Action at 5. The examiner’s final Office Action generally affirmed his initial conclusion as to obviousness without specifically discussing the grammar features.. March 27, 1997, Final Office Action at 2. The Board subsequently affirmed the examiner’s decision to reject claim 11, noting that the examiner set forth sufficient reasoning for asserting the obviousness or inherent nature of each of the claimed features, and therefore, ‘the Examiner’s reasoning is sufficient to shift the burden of Appellants to come forward with evidence and/or arguments to rebut the Examiner’s position’ Decision on Appeal at 9, accord

Appellants urge that this rejection was improper because there is no evidence in the record to prove that the following limitation of claim 11 would be obvious:

d. a means for extracting a grammar from a hypermedia source on said information resource for future reference to said source;

e. a means for modifying said grammar;

....

g. a means for processing said grammar to produce a reference to said hypermedia source.

Even if all of the limitations of claim 11 were present in the prior art, appellants urge that there is no teaching or suggestion supporting the combination of these references.

We agree with appellants that the Board’s ground of rejection is simply inadequate on its face.....”

As to claim 14, the position of the CAFC was the same as to claim 11 as noted at page 15 of the slip opinion. The CAFC therefore vacated and remanded for further proceedings before the Board.

The facts are that the rejection of claims 11 to 14 by the examiner as affirmed by the Board was held to be “simply inadequate on its face” as noted at page 13 of the slip opinion. Plain and simply, this is a reversal of the rejection of record with authorization to provide a different ground of rejection, if available, for consideration. Nothing more.

In view of the JUDGMENT of the CAFC, the Board remanded the application to the examiner. In the remand the Board explicitly stated at page 2 that “[a]ccordingly, in any future formulation of an obviousness rejection of independent claims 11 and 14, the Examiner is requires, as a starting point, to provide clear evidence of the existence in the prior art of grammar creation capability in speech recognition systems.” The Board then stated that “[t]he Examiner must therefore determine the precise scope of the appealed

claims consistent with 35 U.S.C. § 112, sixth paragraph, and must consider how the art of record, as well as any newly discovered prior art, may be applicable to the determination of the patentability of properly construed claims 11 to 19.”

In response, the examiner rejected claims 11 and 14 under 35 U.S.C. 112, second paragraph, which the Director, Mr. Powell, stated was unfounded and should be withdrawn and returned the case to the art unit for final consideration and that unless the examiner had present knowledge of the existence of a particular reference(s) that provides clear and convincing evidence of the unpatentability of the claims at issue the case shall be passed to issue.

A Notice of Allowance was then issued and the issue fee was timely paid.

Subsequent to the payment of the issue fee, the examiner issued a paper dated March 23, 2004, in which he then attempted to possibly narrow the scope of the claims on appeal on which he was summarily reversed. This is not only a matter of pique and contrary to basic fairness. but, in addition, at this point in the prosecution of this application, the examiner no longer had jurisdiction in this application other than to withdraw it from issue for a proper reason (which he did not do). His action was an ultra vires act that cannot be condoned.

In view of the above, it is clear that the paper dated March 23, 2004 should have no standing in the subject application and should therefore be removed from the file of the subject application and such action is respectfully requested

Respectfully submitted,



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